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09/284,862 04/22/99 KURIYAMA

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EXAMINER

BEX, P

ART UNIT

PAPER NUMBER

1743

DATE MAILED:

03/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/284,862

Applicant(s)

KURIYAMA ET AL.

Examiner

P. K. Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Specification*

1. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be limited to a single paragraph on a separate sheet within the range of 50 to 250 words.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claims 1, 4 and 6 “the examination rack” limitation is not supported within the instant specification. The specification does support a reaction disk 35a & b.

In claim 2, lines 4-5, the specimen introducing part, analyzing part and specimen storage parts are not disclosed as having “lengths” which are equal, but the specification does support equal “heights”, see pages 13-14.

Claim 6, the specification does not support the specimen introducing part 1, the analyzing parts 3 or 4, and the specimen storage part 6 having widthwise dimensions which are a multiple of one of the longitudinal length of the specimen rack. The specification only disclose the widthwise dimensions of the specimen introducing part = w1, the electrolyte analyzing part = w2, the reexamining buffer = w5 and the specimen storage part = w6 at 300 mm, which is a multiple of two of the longitudinal dimension of the specimen rack defined as 150 mm. The other analyzing parts 3 and 4 are set at 1,200 mm which is multiple of eight of the longitudinal dimension of the specimen rack at 150 mm, see page 17, paragraphs 2-3, see Fig. 5.

Art Unit: 1743

The specification does not support the limitation of the analyzers having "patterns" which are identical with one another or the analyzing parts having both "patterns" and an "identification" part, as disclosed in claim 8, line 6, see pages 11-12.

3. In specification on page 27, lines 7-10, reference no. 4 should be changed to reference no.

3. Further, Fig. 9c should be changed to Fig. 9d, see page 27, third paragraph.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "6" has been used to designate both the specimen storage part and specimen introduction part, see page 10, lines 8-9. Correction is required.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "5" and "6" have both been used to designate the specimen storage part, see page 10, line 17. Correction is required.

6. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the reference no. 3 in Fig. 6 as described in the specification on page 19, reference no. 140, see page 22, line 23, or reference no. 20a, see page 24, line 21. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

7. Examiner believes that Fig. 5 has misidentified the appropriate structures. The specification discloses that analyzer 3 having a width =  $w_3$ , and the widths for structures 1 and 2 are equal, see page 17, paragraphs 2-3.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1743

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from the foreign document and are replete with grammatical and idiomatic errors. Example of some unclear and indefinite terms used in the claims are:

Claim 1, lines 6-7, "the examination rack" lacks antecedent basis in the claims. Same deficiency was found in claims 4 and 6.

Line 6, the "analyzer part pipetting a specimen" is not clear since no "pipette" has been disclosed. Same deficiency was found in claims 4 and 6.

Line 14, "the analyzer storage part" lacks antecedent basis. Same deficiency was found in claims 4 and 6.

Claim 2, lines 4-5, the specimen introducing part, analyzing part and specimen storage parts are not disclosed as having "lengths" which are equal is vague and indefinite. On which axis is the length measured?

Claim 4, last line, "their contact parts" lack antecedent basis. What contact parts?

Claim 7, line 2, "wherein slits" should be changed to -- comprising a plurality of slits -- for clarity.

Claim 8, lines 6-7, "the analyzing parts" lacks antecedent basis. The claim only disclose a single analyzing part on lines 3-4 of the claim.

Claim 9, lines 2-3, "the housing" lacks antecedent basis. Same deficiency was found in claims 11 and 13.

Claim 11, the limitation "the other part" of the front surface is confusing. What other part is applicant referring to? Same deficiency was found in claim 14.

Claim 12, the limitation "at positions where the user carries out confirmation, adjustment and replacement". The statement is confusing and indefinite.

Penultimate line, "the user" lacks antecedent basis.

11. Applicant is required to review and correct these errors so that the claims conform with the U.S. patent practice.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto *et al* (JP 63-217273).

Okamoto *et al* anticipate the instant claims by teaching an modular analyzer system comprising a specimen rack 30, a specimen introducing part 12, a specimen rack conveying parts 14A-B, a storage part for storing the specimen 24, three analyzers 18A-B wherein the introducing part, the storage part and the analyzers are independent of each other (Fig. 1, 4-6), the analyzers each comprising pipette assembly and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and coupled

Art Unit: 1743

along the longitudinal direction of the conveyers (Figs.1-2). Note: Okamoto *et al* teach stages 20A on the top surface of the supply, storage and analyzing parts (Figs. 1, 3).

14. Claims 1, 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakatake (USP 5,380,488).

Wakatake anticipate the instant claims by teaching an modular analyzer system comprising a specimen rack 2, a specimen introducing part Y1, a specimen rack conveying parts 10, 15, 25, a storage part for storing the specimen, three analyzers D1-D3, wherein the introducing part, the storage part Y4 and the analyzers are independent of each other (column 2, line 61-62), the analyzers each comprising pipette assembly (column 3, lines 35-65) and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and couple along the longitudinal direction of the conveyers (Fig1). Note: Wakatake teach a reexamining buffer for temporarily holding a specimen after analysis is complete (column 3, line 66- column 4, line 3).

15. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yamada *et al* (JP 3-285175).

Yamada *et al* anticipate the instant claims by teaching an modular analyzer system comprising a specimen rack 3, a specimen introducing part 2, a specimen rack conveying parts 10, 12, a storage part for storing the specimen 8, three analyzers 4, 6 wherein the introducing part, the storage part and the analyzers are independent of each other (Fig. 1, 4-6), the analyzers each comprising pipette assembly 20 and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and couple along the longitudinal direction of the conveyers (Fig.1).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 2, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakatake (USP 5,380,488).

Wakatake as discussed above, fails to explicitly state that the modular units of the analysis system are not of equal length. However, it would have been obvious to one of ordinary skill in the art at the time to have made the system parts at a standard uniform dimension so that even if the analyzers are separated or replaced and again combined to form the analysis system, location is easy and no fine adjustment is required. This insures the analyzer can be structured at low cost.

With respect to the specific heights and depths of the units, one of ordinary skill in the art would have found it obvious to have provided the modular units of Wakatake with a particular



Art Unit: 1743

height and depth, in order to optimize the ability of the average observer to work at the units.

Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

18. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakatake (USP 5,380,488) in view of (JP 62-1603).

Wakatake as discussed previously, does not disclose the use of identification means and patterns on the front of the modular units. However, JP 62-1603 does teach the use of an identification means 17 comprising a pattern on the front of an analyzer 14 (Fig. 1).

Accordingly, it would have been obvious to one of ordinary skill in the art to include in on the units of Wakatake an identification and pattern on the front of a modular unit, as taught by JP 62-1603, in order to identify analysis procedure of the units without having to open the cover of the equipment.

19. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto *et al* (JP 63-217273~~0~~).

Okamoto *et al* as discussed above, fails to explicitly state that stages have a color which is different from that of the housing. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of the invention to color code the stages. Such use of color-coding allows for quick and distant identification of the units.

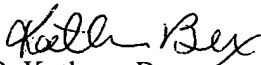
Art Unit: 1743


**Conclusion**

20. No claims allowed.
21. The prior art made of record and not relied upon which is considered pertinent to applicant's disclosure are *et al*, *et al*, *et al*. They are cited of interest in that they show various
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays from 6:30 am to 4:00 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
P. Kathryn Bex  
Patent Examiner  
AU 1743  
February 27, 2001

  
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